

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MORTIMER BROWN and IAN B. KUZNICK

Appeal No. 1998-1965
Application No. 08/357,325¹

ON BRIEF

Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7 and 10 to 20. Claims 8 and 9 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. No claim has been canceled.

¹ Application for patent filed December 16, 1994.

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Application No. 08/357,325

We REVERSE.

BACKGROUND

The appellants' invention relates to an office paneling system with insert module. An understanding of the invention can be derived from a reading of exemplary claims 1, 11 and 18 (the independent claims on appeal), which are set forth in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Miller	4,539,243	Sept. 3,
1985		
Kelley et al.	5,038,539	Aug. 13,
1991		
(Kelley)		

Claims 11 to 15 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Miller.

Claims 1 to 7, 10 and 16 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kelley in view of Miller.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed May 27, 1997) and the examiner's answer (Paper No. 17, mailed February 18, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed December 29, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 7 and 10 to 20 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification necessary to arrive at the claimed invention. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With this as background, we turn to the subject matter of the independent claims under appeal.

Claim 1 reads as follows:

An office panelling system comprising a series of mechanically connected office panels defining an office work space, each of said panels having a support frame selectively covered by releasable elements applied to opposite sides of said frame and forming part of an exterior surface of the respective panel, said panels also including insert modules defining open or light transmitting ports through said panels, each insert module having a dominant rectangular frame component and a secondary rectangular frame component, said dominant rectangular frame component being releasably secured to said frame and providing a finish surface to one side of said frame, said secondary rectangular frame component being positioned to the opposite side of the frame and aligned with said dominant rectangular frame component and providing a finish surface on said opposite side of said frame, and wherein said secondary rectangular frame component is releasably secured to and supported by said dominant rectangular frame component.

Claim 11 reads as follows:

An insert module for providing a light transmitting port through an office panel of an office panelling system, said insert module having a dominant component and a secondary component, said secondary component releasably engaging and being supported from said dominant component in a manner to maintain alignment of said components, each component having a rectangular outer frame finish portion for defining the outer perimeter of said light transmitting port, said dominant component further including a fastening arrangement for engaging a frame of an office panel for supporting said module therefrom.

Claim 18 reads as follows:

In combination an insert module and an office panel of an office panelling system, said insert module defining a light transmitting port through said office panel, said insert module having a dominant component and a secondary component, said secondary component releasably engaging said dominant component and being supported from said dominant component in a manner to maintain alignment of said components, each component having a rectangular outer frame finish portion for defining the outer perimeter of said light transmitting port, said dominant component further including a fastening arrangement engaging a frame of said office panel and supporting said module from the frame with said dominant component on one side of said frame and said secondary component on the opposite side of said frame.

Next, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Miller's invention relates to a glazing system, and has particular application to the provision of glazing trim. The glazing trim comprising two complementary extrusions (e.g., base glazing member 10 and locking glazing member 20) having inter-engaging teeth (e.g., tooth 19 and teeth 23), enables the extrusions to be connected together at different spacings, enabling the glazing trim to accommodate sheets of different thicknesses. The glazing trim can be constructed on site by

cutting the extrusions to length, and inter-engaging the locking teeth of the complementary extrusions by tilting one of the extrusions about a portion of the other until their teeth engage. A sheet of material (e.g., a window pane) can be held in place by resilient gaskets and wedges (e.g., backing gasket 31 and glazing wedge 32) interposed between the sheet and the extrusions. Miller illustrates in Figures 1-11 several shapes of extrusions, together with a variety of different applications for the glazing trim. Miller teaches (column 2, lines 36-68) that

[i]n order to assemble the glazing trim, for example in the formation of a window, the timber or other frame can be constructed, and the glazing trim cut to size to fit within the opening defined by the frame. The glazing trim can conveniently be connected together in butt fashion at the corners, and thus for example the vertical glazing members can run the entire height of the window frame, whilst the horizontal glazing members can run the distance between the vertical glazing members. . . . The base sections can then be fitted to the frame by appropriate fasteners such as nails, screws or the like. The fasteners conveniently pass through the base of the base section, through the groove 14

which serves as a locating groove. The resilient backing gasket 31 can then be fitted to the top flange of each of the base section members 10. The optional setting block members 34 can then be provided along the bottom base section 10, and as the setting blocks are conveniently provided in short lengths, they can be spaced apart from one another at convenient spacings depending upon the size of sheet 30 to be fixed between the glazing members. Then the sheet 30 is positioned

on the setting blocks, and pressed against the backing gaskets. The side locking sections, are then inserted, then the top locking sections. They can be inserted by pivoting them slightly to ride under the tooth 19 of the base section members. . . . The glazing wedges 32 can then be inserted in the sides and top, and finally the bottom locking section positioned, and its glazing wedge inserted.

Kelley's invention relates to work space management systems. In one of its aspects, the invention relates to a work space management system wherein walls are easily constructed, configured and changed, and wherein modular functional wall tiles and work tools are easily configured, changeable and relocatable within the system without interfering with the underlying rigid frame structure. As shown in Figures 2, 22-25 and 28, the system includes a window tile 30d which provides visual and light porosity to the work space. The window tile 30d can thus function as a window between work stations on opposite sides of a frame 40. As shown, window tile 30d has an outer casement 38 which supports light-transmitting pane 38a of glass or plastic and which covers the sides of the frame members 42. Alternatively, Kelley teaches (column 8, lines 12-16) that

a trim segment can be attached to an interior steel frame to enable pass-through access from one side of the pane to another. If desirable, a clear panel of glass or plastic can be placed between the trim segments to make a window.

Referring now to Figures 18 and 19, Kelley discloses a wall 16 having mounted thereto a pull down shelf tile 238. This tile comprises a solid rectangular member 240 having a rectangular recess 242 formed in a front 244 of the tile. A rectangular shelf 246 having substantially the same dimensions as the rectangular recess 242 is pivotally mounted within the recess at a bottom 248 of the solid rectangular member 240. The shelf tile 238 is mounted to the frame 40 in the same manner as the display tile 184 (see Figures 12 and 13).

In both rejections before us on appeal, the examiner relies upon Miller as teaching and/or suggesting (1) the claimed dominant frame component and secondary frame component as recited in claim 1, and (2) the claimed dominant component and secondary component as recited in claims 11 and 18, except for the claimed rectangular shape.

The appellants argue that since Miller's glazing trim is cut into pieces which are then separately attached to the frame in butting relationship, Miller does not teach or suggest the claimed dominant component and secondary component as recited in claims 1, 11 and 18. In that regard, the appellants point out that Miller's glazing trim pieces are not interconnected to form a frame defining the claimed light transmitting port. In fact, the appellants point out that Miller teaches to specifically avoid the fabrication of frames (see column 1, lines 8-20, and column 4, lines 1-9, of Miller).

In view of the contrary positions taken by the examiner and the appellants concerning the teachings of Miller, it is essential for us to properly determine the scope² of claims 1, 11 and 18.

² In proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Claims 11 and 18 both recite that the "insert module" has "a dominant component and a secondary component" and that each component has "a rectangular outer frame finish portion for defining the outer perimeter of said light transmitting port." In our view, these limitations taken together would properly be interpreted by one of ordinary skill in the art as requiring

(1) each component to have a unitary/integral finish portion (e.g., border) defining the outer perimeter of the light transmitting port, and (2) the shape of the unitary/integral finish portion (e.g., border) is rectangular.

Claim 1 recites that the "insert module" has "a dominant rectangular frame component and a secondary rectangular frame component." In our view, these limitations taken together would properly be interpreted by one of ordinary skill in the art as requiring each component to have a unitary/integral finish portion (e.g., border) in the shape of a rectangle.

It is our determination that the above-noted limitations of claims 1, 11 and 18, are not taught or suggested by Miller

since Miller's glazing trim pieces are not interconnected to form a unitary/integral finish portion (e.g., border). Additionally, it is our opinion there is no suggestion in the combined teachings of Miller and Kelley to arrive at the claimed invention as set forth by claims 1, 11 and 18.

For the reasons stated above, the decision of the examiner to reject claims 1 to 7 and 10 to 20 under 35 U.S.C. § 103 is reversed.

Lastly we note that the drawing objection set forth by the examiner on pages 3 and 4 of the answer relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review this issue raised by examiner.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 to 7 and 10 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MURRIEL E. CRAWFORD)	
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APPEAL NO. 1998-1965 - JUDGE NASE
APPLICATION NO. 08/357,325

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APJ CALVERT

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 13 Apr 99

FINAL TYPED:

AIR MAIL DECISION